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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,315	01/18/2002	Katharine M. Martin	J&J-2086	1178
27777	7590	11/20/2003	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			JIANG, SHAOJIA A	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/052,315	Applicant(s) MARTIN ET AL.	
	Examiner Shaojia A Jiang	Art Unit 1617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 17,19,21,22,24-26 and 28.

Claim(s) withdrawn from consideration: 1-16, 18, and 20.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

11/18/03

Advisory Action

This Office Action is a response to Applicant's proposed amendment and response after FINAL filed on October 30, 2003.

2. Applicant's proposed amended claims and proposed new claims herein, for example, "A method of promoting a composition comprising Hedychium extract said method comprising promoting said product for regulating the firmness or tone of skin or regulating wrinkles in skin" in proposed new claim 31, present a new issue for search and consideration by the Examiner.

5. Applicant's remarks filed October 30, 2003 with respect to the rejection of claims 17, 19, 21-22, 24-26 and 28 made under 35 U.S.C. 112, first paragraph, for lack of enablement, have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action dated July 28, 2003.

Applicant asserts that the claimed compositions have shown to achieve such regulation, for example, the product Renova®, the label has been approved by the FDA for the use in the mitigation (palliation) of fine wrinkles. However, the instant claims are not drawn to the treatment of the mitigation (palliation) of fine wrinkles, but methods of **regulating** the firmness or tone of skin of a subject or regulate wrinkles in skin of a subject. As indicated in the Final Rejection, Applicant's own definition of "regulating the firmness of skin", clearly means regulating the firmness, tone, or texture of skin of a subject or regulating wrinkles in skin of a subject, i.e., preventing the loss of firmness or elasticity of skin, also including preventing, retarding, arresting, or reversing the wrinkles

in the skin (see page 3 lines 1-20 of the specification). One skill in the art would recognize that the treatment of the mitigation of fine wrinkles would be clearly distinct from preventing the loss of firmness or elasticity of skin, or preventing or reversing the wrinkles in the skin. Moreover, the recitation of "regulating" in the claims also reads on decreasing the firmness tone, or texture of skin of a subject since regulation encompasses both increasing and decreasing the firmness tone, or texture of skin of a subject.

Again, as discussed in the Final Rejection, in view of the Wands factors as discussed above, to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to achieve methods of regulating the firmness or tone of skin of a subject or regulate wrinkles in skin of a subject, including preventing, retarding, arresting, or reversing the wrinkles in the skin, with no assurance of success.

Applicant's remarks filed October 30, 2003 with respect to the rejection of claims 17, 19, 21-22, 24-26 and 28 made under 35 U.S.C. 102(b) as being anticipated by Shiseido Co. Ltd (JP 61291515), have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action dated July 28, 2003.

Applicant's remarks filed May 12, 2003 in Paper No. 9 with respect to this rejection of claims 17, 19, 21-22, 24-26 and 28 made under 35 U.S.C. 102(b) as being anticipated by Shiseido Co. Ltd. (JP 61291515) have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action dated July 28, 2003.

Applicants assertion that "The '515 patent does not disclose the topical application of such a composition to such skin. Rather, the '515 Patent discloses the application to sunburned skins to rough skinz razor, rashed skin, and inflamed skin" is not found convincing because the treatment of hot feeling after sunburn, rough skin, razor rash and inflammation, is topical application to the skins. As discussed in the Final Rejection, one of ordinary skill in the art would clearly recognize that sunburn, rough skin, razor rash and inflammation are liable to damage or affect skin firmness, tone, or cause wrinkles. Hence, the certainty for the inherent treatment herein as one criteria for determining inherency is clearly seen here, not mere probability or possibilities. The skin of the patient suffering after sunburn, rough skin, razor rash and inflammation would be certainly in need of such treatment because of affected or damaged skins as to the firmness, tone, or wrinkles of the skin in that patient.

Thus, as discussed in the previous Office Action, Shiseido's method inherently treats the skin in a subject for regulating the firmness, tone, or texture of skin of a subject or for regulating wrinkles in skin of a subject, as claimed herein since Shiseido's method steps are same as the instant method steps. See *Ex parte Novitski*, 26 USPQ 2d 1389. Thus, Shiseido Co. Ltd anticipates the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. A. Jiang, Ph.D.
Patent Examiner, AU 1617
November 18, 2002